

REMARKS

In the Office Action,¹ the Examiner rejected claims 1-19 and 24-30 under 35 U.S.C. § 101 as being purportedly directed to non-statutory subject matter; and rejected claims 1-30 under 35 U.S.C. § 103(a) as being purportedly unpatentable over International Publication No. WO 01/018674 to Maloney et al. ("*Maloney*") in view of U.S. Patent No. 5,097,810 to Fishman et al. ("*Fishman*").

Rejection of Claims 1-19 and 24-30 under 35 U.S.C. § 101

Applicants respectfully traverse the rejection of claims 1-19 and 24-30 under 35 U.S.C. § 101, because the claims produce a useful, concrete, and tangible result.

The Examiner states, "Method claim 1 does not recite any electrical, chemical, or mechanical acts or results," as a basis for the § 101 rejection. Office Action, p. 4. The Examiner appears to allege that an electrical, chemical, or mechanical act or result is a requirement of a statutory process claim, because *AT&T Corp. v. Excel Communications, Inc.*, 172 F.3d 1352 (Fed. Cir. 1999), states, "any step-by-step process, be it electronic, chemical, or mechanical, involves an 'algorithm' in the broad sense of the term." This is incorrect.

Whether a claim includes electronic, chemical, or mechanical acts or results is not a proper test in determining whether a claim is patentable under 35 U.S.C. § 101. Read in context, "electronic, chemical, or mechanical" recitation in *AT&T* is merely a

¹ The Office Action contains a number of statements reflecting characterizations of the related art, case law, and the claims. Regardless of whether any such statement is identified herein, Applicants decline to automatically subscribe to any statement or characterization in the Office Action.

non-comprehensive list of examples of process claims. *AT&T*, in no way, implies that all statutory process claims must include electronic, chemical, or mechanical acts or results. Contrary to the Examiner's interpretation of *AT&T*, electronic, chemical, or mechanical acts or results are not necessarily required for a claim to be statutory. Therefore, even assuming that claim 1 lacks any electronic, chemical, or mechanical acts or results, which Applicants do not concede, claim 1 is not rendered non-statutory by this reason.

The Examiner further states, "claim [1] does not require any machine or apparatus to perform the recited steps," as a basis for the § 101 rejection. Office Action, p. 4. The Examiner appears to allege that all process claims require a machine or an apparatus to perform the recited steps in order to be statutory. Applicants submit that the Examiner's allegation is incorrect; and, furthermore, the Examiner provides no legal support for the allegation. Therefore, even assuming claim 1 does not require a machine or an apparatus to perform the recited steps, which Applicants do not concede, claim 1 is not rendered non-statutory by this reason.

The Examiner further states, "claim [1] does not provide any physical transformation of an article to a different state or thing, nor does it require any transformation of data or signals," as a basis for the § 101 rejection. Office Action, p. 4. The Examiner appears to allege that a physical transformation of an article, data, or a signal to a different state or thing is a requirement of a statutory process claim, because *In re Schrader*, 22 F.3d 290 (Fed. Cir. 1994), states, "a process claim [in] compliance with § 101 requires some kind of transformation or reduction of subject matter." This is incorrect.

A physical transformation is not a requirement for a process claim to be statutory. After *In re Schrader*, the court in *AT&T* explained that “[physical transformation] is not an invariable requirement, but merely one example of how a mathematical algorithm may bring about a useful application,” noting that *Diamond v. Diehr*, 450 U.S. 175 (1981), used the “e.g.” signal denoting an example, not an exclusive requirement. *AT&T*, 172 F.3d at 1358. Accordingly, a physical transformation is just one example of how a mathematical algorithm can be shown to be useful, but is not an absolute requirement for a process claim to be statutory. Therefore, even assuming that claim 1 does not provide a physical transformation, which Applicants do not concede, claim 1 is not rendered non-statutory by this reason.

The Examiner further states, “claim [1] is so broad that it is directed to the abstract idea itself. Office Action, p. 4. The Examiner appears to allege that claim 1 is directed to an abstract idea because claim 1 is broad. However, breadth of a claim is neither a basis nor a factor in determining whether a claim is directed to an abstract idea or whether a claim is statutory. Therefore, even assuming that claim 1 is broad, as the Examiner opined, claim 1 is not rendered non-statutory by this reason.

In view of the foregoing, none of the Examiner’s bases for the rejection under 35 U.S.C. § 101 is valid.

Furthermore, the Examiner correctly states that “[i]n determining whether the claimed subject matter is statutory under 35 U.S.C. 101, . . . [the] test should be . . . whether a ‘useful, concrete and tangible result’ is accomplished.” Office Action, p. 2. Applicants have previously provided several reasons why Applicants’ claims produce useful, concrete, and tangible results. See Request for Reconsideration filed on July 5,

2007 at pp. 3-4; Reply to Office Action filed on July 11, 2006 at pp. 3-6; Reply Brief filed on December 5, 2005 at pp. 3-4, Appeal Brief filed on July 22, 2005 at pp. 19-20; and Reply to Office Action filed on June 14, 2004 at pp. 9-12. However, rather than addressing Applicants' arguments, as required by M.P.E.P § 707.07(f) ("The Examiner must address all arguments which have not already been responded to in the statement of the rejection."), the Examiner merely makes conclusory statement that "claim 1 falls outside the scope of § 101 as failing to . . . produce a useful and concrete and tangible result." Office Action, p. 4. Applicants submit that claims 1-19 and 24-30 produce useful, concrete, and tangible results, and are thus statutory for at least the reasons previously provided in this application. If the Examiner chooses to maintain the § 101 rejection, Applicants respectfully request that the Examiner directly address all the arguments herein and previously provided by Applicants and that the Examiner apply the correct standard for determining patentability under 35 U.S.C. § 101. For the foregoing reasons, Applicants respectfully request that the Examiner reconsider and withdraw the rejection of claims 1-19 and 24-30 under 35 U.S.C. § 101.

Rejection of Claims 1-30 under 35 U.S.C. § 103(a)

Applicants respectfully traverse the rejection of claims 1-30 under 35 U.S.C. § 103(a) as being purportedly unpatentable over *Maloney* in view of *Fishman*, because a *prima facie* case of obviousness has not been established.

"The key to supporting any rejection under 35 U.S.C. 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious. . . . [R]ejections on obviousness cannot be sustained with mere conclusory statements." M.P.E.P.

§ 2142, 8th Ed., Rev. 6 (Sept. 2007) (internal citation and inner quotation omitted).

“[T]he framework for objective analysis for determining obviousness under 35 U.S.C. 103 . . . [includes] [a]scertaining the differences between the claimed invention and the prior art.” M.P.E.P. § 2141(II). “Office personnel must explain why the difference(s) between the prior art and the claimed invention would have been obvious to one of ordinary skill in the art.” M.P.E.P. § 2141(III).

A *prima facie* case of obviousness has not been established because the Examiner has not properly ascertained the difference between the prior art and the claimed invention, and thus has failed to clearly articulate a reason why the prior art would have rendered the claimed invention allegedly obvious to one of ordinary skill in the art.

Independent claim 1 recites “based on the received answers, selecting from a plurality of testing materials, at least one customized set of testing material.” Although *Maloney* discloses “providing the consumer a test kit” (p. 11, lines 6-7), *Maloney* does not disclose selecting the test kit “based on . . . received answers,” as recited in claim 1. Applicants have previously argued, in the Request for Reconsideration filed on July 5, 2007, that *Maloney* fails to teach or suggest basing the selection of the test kit on received answers. However, the Examiner has not addressed Applicants’ argument. Instead, the Examiner states, “Maloney teaches selecting said at least one set of testing material.” Office Action, p. 6. The Examiner appears to be avoiding the issues that *Maloney* fails to teach selecting at least one set of testing material based on received answers, and the Examiner also does not appear to acknowledge that *Fishman* does not cure *Maloney*’s deficiencies. Rather, the Examiner cites *Fishman* as a teaching of

“a method and system for skin allergy testing, wherein a *customizable* allergen carrier (set of testing materials) 400 is provided for conducting allergy test on a person’s skin.” *Id.* (emphasis in original). Regardless of whether the Examiner’s characterization of *Fishman* is correct, *Fishman* fails to teach or suggest “based on the received answers, selecting . . . testing material,” as recited in claim 1. Thus, *Fishman* fails to cure the deficiencies of *Maloney*.

Because *Maloney* and *Fishman*, individually or in combination, fail to teach or suggest all the features of claim 1, the Examiner has not properly ascertained the differences between the prior art and claim 1. Therefore, the Examiner has failed to clearly articulate a reason why the prior art would have rendered claim 1 allegedly obvious to one of ordinary skill in the art. Accordingly, a *prima facie* case of obviousness has not been established with respect to claim 1.

In addition, independent claims 11, 20, 24, and 25, although different in scope from claim 1, include recitations having at least some similarity to the above-quoted recitations of claim 1. For example, each of claims 11, 20, and 24, recites “based on the received answers, selecting . . . at least one customized set of testing material,” and claim 25 recites “based on the received information, selecting . . . at least one customized set of testing material.” *Maloney* and *Fishman* fail to teach these features of claims 11, 20, 24, and 25 for at least reasons similar to those given above with respect to claim 1. Also, dependent claims 2-10, 12-19, 21-23, and 26-30 are allowable over *Maloney* and *Fishman* at least by virtue of their dependence from allowable base claims 1, 11, 20, and 25. Therefore, a *prima facie* case of obviousness has not been established with respect to claims 1-30. Accordingly, Applicants respectfully request

that the Examiner reconsider and withdraw the rejection of claims 1-30 under 35 U.S.C. § 103(a).

New Claims

Applicants have added new claims 31-34, which depend from claims 1, 11, 24, and 25, respectively. These new claims should be allowable for at least the same reasons as the claims from which they respectively depend.

Conclusion

Applicants respectfully request reconsideration of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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